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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,053	07/23/2001	Pradeep K. Bansal	1999-0215	3729

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Samuel H. Dworetsky  
AT&T Corp  
Room 2A-207  
One AT&T Way  
Bedminister, NJ 07921

EXAMINER

ZURITA, JAMES H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/911,053	<b>Applicant(s)</b> BANSAL ET AL.	
	<b>Examiner</b> James H Zurita	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 17-49 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10 September 2001</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 17-49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 20 November 2004.

Claims 1-16 will be examined.

### ***Response to Preliminary Amendment***

Applicant filed a preliminary amendment on 10 September 2001, wherein he amended claim 23. Applicant also amended several portions of his specification, and presented Fig. 10B.

The preliminary amendment is entered en examined herewith.

### ***Drawings***

The replacement drawings submitted in a preliminary amendment on 21 September 2001 are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

Fig. 1A, item 112.

Fig. 8B, items 814, 816 and 818.

Fig. 10B, item 1023, paragraph 49.

The following lines appear to have various errors:

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	<b>Fig. 10B</b>	<b>Fig. 11B</b>	<b>Fig. 12B</b>	<b>Fig. 13B</b>
Need direction arrow	from 1020-1021	From 1120-1121	from 1219-1218	from 1320-1321
	from 1020-1022	From 1120-1122	from 1219-1220	from 1320-1322
	From 1018-1022	From 1118-1122	from 1216-1220.	from 1318-1322
	From 1026-1027	From 1126-1127		
	From 1026-1028	From 1126-1128		
	From 1024-1026	From 1124-1128		
extraneous	from 1017-1023	from 1117-1123		
	from 1018-1022	from 1118-1122		
	from 1022-1023.			

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claims 2, 3, 5, 8-10 are objected to because of the following informalities:

Claims 2, 3 and 5 refer to address directory and online address directory. Other claims refer to online address directory. For purposes of this examination, the terms will be used as synonyms.

Claims 8-10 refer to a predetermined list, rendering the claims indefinite. The claims will be interpreted to refer to a list.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source **human** language (e.g., Russian) into a target **human** language (e.g., English). The court found that the claimed computer implemented process was within the

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"technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a

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§101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, claims 1-16 are drawn to a system but the body of claim 1 contains no mention of technology. The body of claim 1 refers to several types of data that are labeled with nonfunctional descriptive material. To overcome this rejection the Examiner recommends that Applicant amend the claims to better clarify technological components of a system and what is being done by them. For example, a system may include a server, a network and client computers. These particular components may store and run computer-executable instructions to perform various functions.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Li et al. (US 6,012,088).

**As per claim 1**, Li discloses a system for entering data and for providing real time address information. The system consists of an online address directory, including at least one address entry.

1. a name. See, for example, at least Col. 2, lines 19-39.
2. an address for said address owner. See at least Col. 2, lines 5-18.



3. a beginning date for said address. See, for example, Col. 21, lines 39-45.
4. an ending date for said address (expiration date). See, for example, Col. 21, lines 39-45.

Li discloses that the address, beginning and ending dates may be updated to reflect the address for said address owner on a specific date. See, for example, references to enable update, Col. 21, lines 55-67.

**As per claim 2**, Li discloses the use of a unique identifier, as in Col. 2, lines 5-18.

**As per claims 3-4**, Li discloses access to the directory may be set up at the time an entry is established. See references to dynamic access, Col. 2, lines 5-39.

**As per claim 5**, Li discloses that access to the directory is restricted, such that said person may obtain said address in said address directory only by means of a key provided with the address owner's permission. See various types of keys, as in claims 12-14.

**As per claim 6**, Li discloses that restricted access to the address entry for said address owner is set at the time the address entry is established. See references to access, Col. 1, lines 38-58.

**As per claim 7**, Li discloses that an address owner permits access to said address entry to at least one person identified by said address owner at the time the address entry is established. See references to access, Col. 1, lines 38-58.

**As per claim 8**, Li discloses that an address owner selects at least one person from a predetermined list of persons at the time the address entry is established.

**As per claim 9**, Li discloses that one of said persons selected from said predetermined list of persons is a merchant. See, for example, references to carriers, Col. 1, lines 38-58. They are merchants in that they sell telecommunications services to users.

**As per claim 10**, Li discloses that one of said persons selected from said predetermined list of persons is a shipper. See, for example, references to carriers, Col. 1, lines 38-58.

**As per claims 11 and 15**, Li discloses that the identity of a person requesting access to said address owner's address entry is verified at a time a request for access is made and requesting access to an address entry is verified by verifying the source from which access is requested. See, for example, references to validating requests, Col. 6, line 42-67.

**As per claim 12**, Li discloses key is a coded password, said coded password being provided to said person identified by the address owner at the time said person is identified. See, for example, Col. 2, lines 19-39.

**As per claim 13**, Li discloses hyperlink. See, for example, Col. 13, line 60-Col. 14, line 12.

**As per claim 14**, Li discloses that key is a personal identification number. See, for example, references to registration identification number for a customer, as in Col. 10, lines 6-43.

**As per claim 16**, Li discloses that permission to access said address owner's address entry in said online address directory is granted on a transaction by transaction basis. See, for example, at least Col. 2, lines 19-39.

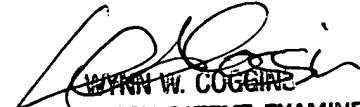
### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JZ  
**James Zurita**  
**Patent Examiner**  
**Art Unit 3625**  
04 March 2005

  
**WYNN W. COGGINS**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3600**